

JA



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,169	12/28/2001	Tadashi Sugiyama	PW 0277031 H7618US	1567

7590 12/30/2005  
 Phillsbury Winthrop LLP  
 Intellectual Property Group  
 Suite 2800  
 725 South Figueroa Street  
 Los Angeles, CA 90017-5406

EXAMINER
----------

GRAHAM, ANDREW R

ART UNIT	PAPER NUMBER
----------	--------------

2644

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/034,169	<b>Applicant(s)</b> SUGIYAMA, TADASHI	
	<b>Examiner</b> Andrew Graham	<b>Art Unit</b> 2644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2644

## DETAILED ACTION

### *Drawings*

1. The drawings were received on 9/30/2005. These drawings have been entered into the application as having overcome the previous grounds of objection, however, it is noted that Figures 7 and 9 comprise typographical errors: In Figure 7, step s30, "reprodused" should be "reproduced" and in Figure 9, steps s51 and s52, "albam" should be "album". The applicant's assistance is respectfully requested in addressing or correcting any further such minor typographical errors that have not explicitly noted above.

### *Claim Rejections - 35 USC § 112 -1<sup>st</sup> paragraph*

The following is a quotation of the first paragraph of 35 U.S.C.

112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 1-3** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, each of the amended claims comprise the limitation "without erasing file management information on said storage section" or a limitation

Art Unit: 2644

similar thereto. This limitation incorporates new matter. The file management information in the present application is shown in Figure 4B (per page 15, of originally filed specification). While the present application positively recites the changing of the erasure state and validity flags, (page 16), the present specification is silent to the treatment (or lack thereof) of any other of this data shown in Figure 4B. The mere absence of a positive recitation is not basis for an exclusion. Please see MPEP 2173.05(i). Appropriate correction or clarification is required.

***Claim Rejections - 35 USC § 112 -2<sup>nd</sup> paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-3** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. **Claims 1-3** recite "without erasing file management information on said storage information" as part of a "first" operation upon information in the "storage section". However, such an operation, as defined in the specification involves the erasure state flag being "set to indicate an erased state" (page 16, line 11-13). Claims 2 and 3 particularly describe this process as "rewrites" and "sets to". The underlying process for each of these "first" controls

Art Unit: 2644

or operations involves the changing, or "erasure" of information, so far as said information was represented prior to the "rewrite" or "set" operations. The information (i.e., that there are data in the storage section) represented by the flag prior to the "rewrite" or "set" is deleted or erased by these operations by virtue of fact that, after said operations, indication that there are data in the storage section has been removed or is no longer present in the storage section. As such, these operations of "rewriting" or "setting", so far as they are incorporated implicitly or explicitly in Claims 1-3, involve the "erasure" of file management information. As such, Claims 1-3, as amended, fail to distinctly claim the subject matter which the applicant regards as his or her invention.

4. **Claims 1-3** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The claims recite the functional limitation of "such that the digital audio data stored on said storage section can not be accessed by any other operation other than said write operation". In light of this limitation, the omitted elements are: the indication that such "other operations" involve the checking of the "erasure state flag", such that its modification results in their inoperability. The applicant's statement of "can not be accessed by any operation other" hinges on the concept of all other operations, as a part of their attempts to access the correlated audio data, check this "erasure state flag" (thus resulting in the file being "treated" as erased, per page 15,

Art Unit: 2644

lines 20-24). However, if one of these "other operations" does not involve the checking of the "erasure state flag", or permitted the flag to be ignored, then such "treatment" as erased would not be effectuated (similar to the operation of the write process).

Accordingly, a limitation in the claimed apparatuses that the "other" operations check this erasure state flag as part of their processing procedures is critical to the cooperative relationships of elements, particularly the "cannot be accessed by *any operation other*" limitation. As such, the presented claims fail to distinctly claim the subject matter which the applicant regards as his or her invention.

5. Claims 1 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims each recite the "such that the digital audio data stored on the said storage section can not be accessed by any other operation other than said write operation". However, after such a "first" control or operation and "after completion of the writing of the digital audio data", the control section "then erases". Thus, the digital audio data can be accessed for purposes of erasing or an erase operation, even though a preceding limitation states that such access, so far as it is given its broadest reasonable interpretation consistent with the specification, is not possible. The operations and the descriptive nature of these operations in Claims 1 and 3 therefore conflict with each other. Accordingly, the presented claims

Art Unit: 2644

fail to distinctly claim the subject matter which the applicant regards as his or her invention.

Appropriate correction or clarification for each of these rejections is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. **Claims 1 and 3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al (USPN 5764607) in view of Fukuda (USPN 6469239 B1). Hereafter, "Maeda et al" will be referred to as "Maeda".

Maeda discloses a system for controlling digital copying of digitally recorded information. The system may be applied to compact disc (CD) as well as other disc and tape formats (col. 9, lines 31-36).

Specifically regarding **Claim 1**, Maeda discloses:

A digital-audio-signal recording apparatus (Figure 1A-1C, col. 4, lines 49-58) comprising:

a storage section (A) storing digital audio data (music information recorded on disk 1, col. 4, lines 25-31 and 49-65);

Art Unit: 2644

a write section (B) that writes ("digitally recorded") data on a disk-shaped storage medium (22) (col. 4, lines 49-65; col. 7, lines 17-21 and 59-66); and

a control section (10) (col. 4, lines 52-58) that,

when a write operation (Figures 4 and 6) to be performed by said write section (B) for writing the digital audio data stored on said storage section (A, stored on disc 1), to the disk-shaped storage medium (22) (col. 6, lines 28-36; col. 9, lines 15-22),

first performs control (S35) such that the digital audio data stored on said storage section can not be accessed by any other operation than said write operation (existence of data is recognized only by management information in TOC(11), col. 8, lines 24-32 and 55-59; col. 9, lines 2-8 and 15-20)

without erasing file management information on said storage section (after S37, management information remains on disc as shown in Table 3, thus, information in Table 3 is not erased, col. 7, lines 1-16)

then causes said write section (B) to write (S41-S43) the digital audio data (on 1 in A) to the disk-shaped storage medium (22) (col. 7, lines 60-67; col. 8, lines 1-5; col. 9, line 18),

While Maeda notes that the original audio information may be erased (col. 9, lines 26-30), Maeda does not clearly specify:

- then erases the digital audio data from said storage section after completion of writing of the digital audio data to the disk-shaped storage medium.



Art Unit: 2644

Fukuda teaches a system for managing the copying of audio data between a hard disc (10 in 50) and a recording apparatus (70) (col. 4, lines 6-12; col. 5, lines 17-39).

Specifically regarding Claim 1, Fukuda teaches:

then erases (S46) the digital audio data from said storage section (50 and 10 of Fukuda in view of A and 1 of Maeda) after completion of writing of the digital audio data to the disk-shaped storage medium (S45) (Figure 9, col. 18, lines 60-67, col. 19, lines 1-26 and 43-51, noting that Fukuda discloses erasing as an alternative to inhibition marking therein)

To one of ordinary skill in the art at the time the invention was made, it would have been obvious to delete or erase the original music information from the recording source A in the system of Maeda after recording the music information in section B, as is taught in step S46 for the system of Fukuda. The motivation behind such a modification would have been that such deleting would have more than merely inhibited the access or reproduction of the music data by the use of secondary information by erasing the data itself, managing the data so that only one copy always exists and preventing an illegal copy of the music data, as is taught by Fukuda. File deletion is also known in the art to free the memory area for other use or allocation, as is evidenced by in the teachings of Shitara et al (USPN 6434103 B1) (see col. 29, lines 52-59).

Art Unit: 2644

Regarding **Claim 3**, Maeda in view of Fukada teaches or at least suggests:

A digital-audio-signal recording apparatus (Figure 1A-1C, col. 4, lines 49-58 of Maeda) comprising:

a storage section (A) storing digital audio data (music information recorded on disk 1, col. 4, lines 25-31 and 49-65 of Maeda);

a write section (B) that writes ("digitally recorded") data on a disk-shaped storage medium (22) (col. 4, lines 49-65; col. 7, lines 17-21 and 59-66 of Maeda); and

a control section (10) (col. 4, lines 52-58 of Maeda) that, when a write operation (Figures 4 and 6 of Maeda) is to be performed by said write section (B) for writing the digital audio data stored on said storage section (A, stored on disc 1), to the disk-shaped storage medium (22) (col. 6, lines 28-36; col. 9, lines 15-22 of Maeda),

first sets an erasure state flag (music number in management information, col. 4, lines 31-34) within file management information (all additional information in TOC on disc 1) to an erased state (former data representing the music number is erased, col. 8, lines 24-26) (so far as the data in the management information for track 3 includes a music number, which is at least a part of the indication of the existence or non-erasure state of track 3, the music number data or bits for track 3 meet the structural requirements of the claimed "erasure state flag"; so far as this number is erased or otherwise

Art Unit: 2644

altered or voided, this meets the structural requirements, as far as mandated by a reasonable interpretation in light of the specification of the limitation of 'sets... to an erased state', when considered in view of the context of the system of Maeda)

without erasing the file management information on said storage section (after S37, management information remains on disc as shown in Table 3, thus, information in Table 3 is not erased, col. 7, lines 1-16 of Maeda)

then causes said write section (B) to write (S41-S43) the digital audio data (on 1 in A) to the disk-shaped storage medium (22) (col. 7, lines 60-67; col. 8, lines 1-5; col. 9, line 18 of Maeda), and

then erases (S46 of Fukuda) the digital audio data from said storage section (50 and 10 of Fukuda in view of A and 1 of Maeda) after completion of writing of the digital audio data to the disk-shaped storage medium (S45) (Figure 9, col. 18, lines 60-67, col. 19, lines 1-26 and 43-51)

Regarding the limitations of this claim, it is noted that incorporating further definition of the claimed 'erasure state flag' (such as the binary values associated with the possible 'states', its inclusion among other information in a subcode, other defining characteristics, etc.) as part of the claim language may provide the necessary distinction from the grounds which have been applied above. At present, such a limitation is subject to a broad, reasonable interpretation, while yet defining the limitation in a manner consistent with the specification. While this statement has been

Art Unit: 2644

provided in an attempt to further prosecute the application, such a suggestion is not to be construed as an indication of future patentability, as, upon formal entry of any such amendment, further search and or consideration may be required.

7. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda in view of Fukuda as applied to claim 1 above, and further in view of Shitara et al (USPN 6434103 B1), hereafter "Shitara".

As detailed above, Maeda discloses a system for controlling digital copying of digitally recorded information. The system may be applied to compact disc (CD) as well as other disc and tape formats (col. 9, lines 31-36). Fukuda teaches a system for managing the copying of audio data between a hard disc (10 in 50) and a recording apparatus (70) (col. 4, lines 6-12; col. 5, lines 17-39).

Specifically regarding **Claim 2**, Maeda in view of Fukuda teaches or at least suggests:

A digital-audio-signal recording apparatus (Figure 1A-1C, col. 4, lines 49-58 of Maeda) comprising:

a storage section (A) storing digital audio data (music information recorded on disk 1, col. 4, lines 25-31 and 49-65 of Maeda);

Art Unit: 2644

said storage section (A) also storing second information (in 1a) for limiting access to the digital audio data (TOC 11)(col. 4, lines 26-30; col. 8, lines 28-32)

a write section (B) that writes ("digitally recorded") data on a disk-shaped storage medium (22)(col. 4, lines 49-65; col. 7, lines 17-21 and 59-66 of Maeda); and

a control section (10)(col. 4, lines 52-58 of Maeda) that, when a write operation (Figures 4 and 6 of Maeda) is to be performed by said write section (B) for writing the digital audio data stored on said storage section (A, stored on disc 1), to the disk-shaped storage medium (22) (col. 6, lines 28-36; col. 9, lines 15-22 of Maeda),

first rewrites, without erasing file management information on said storage section (after S37, management information remains on disc as shown in Table 3, thus, information in Table 3 is not erased, col. 7, lines 1-16 of Maeda) said second information (TOC) into content (1a area)(S35-S37 of Maeda) such that the digital audio data stored on said storage section can not be accessed by any other operation than said write operation (existence of data is recognized only by management information in TOC(11), col. 4, lines 26-30, col. 8, lines 24-32 and 55-59; col. 9, lines 2-8 and 15-20 of Maeda)

then causes said write section (B) to write (S41-S43) the digital audio data (on 1 in A) to the disk-shaped storage medium (22)(col. 7, lines 60-67; col. 8, lines 1-5; col. 9, line 18),

Art Unit: 2644

As noted above, Fukuda teaches erasing (S46) the digital audio data from said storage section (50 and 10 of Fukuda in view of A and 1 of Maeda) after completion of writing of the digital audio data to the disk-shaped storage medium (S45) (Figure 9, col. 18, lines 60-67, col. 19, lines 1-26 and 43-51, noting that Fukuda discloses erasing as an alternative to inhibition marking therein).

However, Fukuda does not provide details regarding this erasing process.

Specifically regarding Claim 2, Maeda in view of Fukuda does not specify:

- said storage section also storing first information for managing presence of the digital audio data
- after completion of writing of the digital audio data the disk-shaped storage medium, rewrites said first information into content such that the presence of the digital audio data is invalidated.

Shitara teaches a system for utilizing management data to control the processing of main audio data on a storage medium.

Specifically regarding Claim 2, Shitara teaches or at least suggests:

- said storage section also storing first information ("invalidity flag") for managing presence of the digital audio data (col. 30, lines 15-18)
- after completion of writing of the digital audio data to the disk-shaped storage medium (after S45 of Fukuda in

Art Unit: 2644

view of s42-44 of Maeda), rewrites said first information (invalidity flag set to "1") into content (additional information file to be deleted in Shitara in view of music data to be deleted in Fukuda) of music data of such that the presence of the digital audio data is invalidated (col. 29, lines 40-45; col. 30, lines 15-26).

As detailed above, Fukuda teaches that the music data may be deleted (s46). As taught by Shitara, the adjustment of an invalidity flag associated with the additional information file results in the file being erased (col. 30, lines 15-18). To one of ordinary skill in the art at the time the invention was made, it would have been obvious to utilize such an invalidity flag with the music data of Maeda in view of Fukuda for the purposes of enabling music data erasure, as is taught for a file by Shitara. The motivation behind such a modification would have been that such a invalidity flag would have enabled deletion processing of the music data to be implemented without manipulating the whole unit of music data, thus not increasing the processing load of the operation. Such a form of deletion is noted by Shitara as comprising very simple processing (col. 34, lines 31-40).

#### ***Response to Arguments***

8. Applicant's arguments filed 9/30/05 have been fully considered but they are not persuasive.

Art Unit: 2644

On page 6, line 22-page 7, line 1, the applicant has stated, "In the Maeda reference, the original digital management information is erased (Maeda, col. 9, lines 15 - 18), before the data is copied from one disk to another, which is the exact opposite of performing control, without erasing file management information, such that the digital audio data cannot be accessed by any operation other than said write operation". The examiner respectfully submits, however, that the definition or extent of the "file management information" is not clearly defined by the amended claim language. Thus, so far as management information, such as the management information for other tracks, is not erased by the processes of Maeda, such a limitation is yet taught or at least suggested by the teachings of Maeda. It is further noted that the concept of 'erasing', as presented in the new or amended limitations, incorporates new matter, as is further detailed above. This response applies to all remarks presented in the response of 9/30/05 that are based on the new or amended limitation of "without erasing".

On page 8, lines 9-14, the applicant has stated, " the applicants also believe that the Fukuda reference and the Maeda reference are not properly combinable" and "In the Fukuda reference, the control action occurs after copying of the music data has occurred, while in the Maeda reference, first the management information is erased and then the copying of the music occurs". The examiner respectfully disagrees. The control operations of the two systems of Maeda and Fukuda operate on two different portions of audio file data. Namely,



Art Unit: 2644

the control of Maeda operates on the management information, and the applied aspect of Fukuda involves the erasure of the audio data, which is at least understood to include the audio file data. As such, Maeda and Fukuda, as applied, cannot properly be construed as teaching away or otherwise uncombinable.

The above responses address the basis of each of the applicant's remarks presented 9/30/05. In view of these responses, the rejections of new or amended Claims 1-3 have been maintained or added herein, as is further detailed above.

#### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2644

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Graham whose telephone number is 571-272-7517. The examiner can normally be reached on Monday-Friday, 8:30 AM to 5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 571-272-7848. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

~~Ag~~

ag

December 27, 2005

  
HUYEN LE  
PRIMARY EXAMINER